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IN THE

Supreme Court of the United States

October Term, 1944. *D.*

No. 1045

COMPANHIA ANTARCTICA PAULISTA, *Petitioner*

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA AND BRIEF IN SUP-
PORT THEREOF.**

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PETITION.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Companhia Antaretica Paulista respectfully prays that a writ of certiorari issue to review the decree of the United States Court of Appeals for the District of Columbia, entered in the above-entitled case on January 15, 1945 (R. p. 15), affirming a decree of the District Court of the United States for the District of Columbia (R. p. 7). A certified transcript of the record in the case, with the necessary

additional copies thereof, has been filed in compliance with Rule 38 of the rules of this Court.

Summary and Short Statement.

The petitioner is a corporation of Brazil, the respondent is Conway P. Coe, Commissioner of Patents, acting in his official capacity. On September 17, 1927 petitioner obtained registration in Brazil of its trade-mark "ANTARCTICA" for soft drinks, syrups and extracts. On July 7, 1941 petitioner filed application Serial No. 445,112 in the United States Patent Office for registration in this country of the same mark for the same goods, stating in its application that the trade-mark sought to be registered had been continuously used and applied to the goods in its business since July 25, 1896.

The respondent, the Commissioner of Patents, acting by the Examiner of Trade-marks, refused registration of "ANTARCTICA" and thereupon petitioner appealed to the Commissioner of Patents, who thereafter on November 18, 1942, affirmed the decision of the Examiner of Trade-marks, and refused registration of petitioner's trade-mark (Commissioner's decision, R. pp. 9-11). The Commissioner cited no registered trade-mark as being in conflict with that sought to be registered by petitioner.

Petitioner then on March 18, 1943 brought this action in the United States District Court for the District of Columbia against the respondent, Commissioner of Patents, under the provisions of Section 9 of the Trade-mark Act of February 20, 1905 (U. S. C., Title 15, Section 89) and under Section 4915 of the Revised Statutes, (U. S. C., Title 35, Section 63). On March 7, 1944 the trial Judge filed an opinion (R. p. 5) holding that the trade-mark "ANTARCTICA" is "merely" a geographical term within the meaning of Section 5 of the Trade-mark Act of February 20, 1905 and therefore is not registerable under the Act; and thereafter, on March 15, 1944, a final judg-

ment dismissing the action was entered (R. p. 7). From the judgment of the United States District Court for the District of Columbia, petitioner appealed to the United States Court of Appeals for the District of Columbia which on January 15, 1945 affirmed the decision of the lower court. (R. p. 15)

The pertinent facts involved are summarized as follows:

- (a) It is common knowledge that "ANTARCTICA" is totally uninhabited, and is a land of perpetual snow and ice incapable of supporting human life. No commerce exists between it and any part of the world.
- (b) "ANTARCTICA" is used by petitioner on its goods in an arbitrary and fanciful sense as a trade-mark, and no one could have need to employ it in the sense of indicating or describing his goods as coming from that region.
- (c) No person upon seeing the mark "ANTARCTICA" affixed to the goods could ever reasonably entertain the belief that it signified the locality where the goods or their ingredients were manufactured or originated.
- (d) "ANTARCTICA" has been used as a trade-mark by petitioner for nearly fifty years and is registered in Brazil. No registered mark has been cited as being in conflict with it, refusal of registration being based solely upon the ground that the mark "ANTARCTIA" is "*merely* a geographical name or term" within the meaning of Section 5 of the Trade-mark registration Act of February 20, 1905 (U. S. C., title 15, sec. 85).

Question Presented.

The sole question is:

What is the proper interpretation of that portion of Section 5 of the Trade-mark registration Act of February 20, 1905 (U. S. C., title 15, sec. 85), which reads:

“Provided, That no mark . . . merely a geographical name or term, shall be registered under the terms of this Act.”

Is the expression “merely a geographical name or term” properly to be interpreted in harmony with the substantive law of trade-marks and in the sense it is used in decisions of this Court expounding that law prior to the passage of the Act, so as thus to permit registration of geographical names which are used in an arbitrary and fanciful sense and thereby perform the office of valid trade-marks at common law by pointing out distinctively the personal origin or ownership of the goods;

Or are all geographical names or terms precluded from registration by this provision of the Act, irrespective of their validity or invalidity as trade-marks at common law?

Reasons for Granting the Writ.

1. The Court of Appeals below has decided an important question of Federal law which has not been, but should be, settled by this Court, namely, the question as to the proper interpretation of the words “merely a geographical name or term” occurring in Section 5 of the Trade-mark Registration Act of February 20, 1905 (U. S. C., title 15, sec. 85).

2. The Court of Appeals below has decided the question here involved in a way probably in conflict with the intent and language of the decision of this Court in *American Steel Foundries v. Robertson*, 269 U. S. 371, wherein, setting forth the manner in which the said Act should be construed, it is stated, pp. 379, 381:

"The answer to this question (as to the meaning of the words "merely the name of a corporation") will be simplified if we approach it by first considering certain *principles of the substantive law of trade-marks and unfair competition, in the light of which the legislation under review must be examined.*

"These principles, it must be assumed, were in mind when Congress came to enact the registration statute. And, since that body has been given no power to legislate upon the substantive law of trademarks, it reasonably may be assumed, also, that, to the extent the contrary does not appear from the statute, *the intention was to allow the registration of such marks as that law, and the general law of unfair competition of which it is a part, recognized as legitimate.* The House Committee on Patents, in reporting the bill which upon enactment became the registration statute in question, said: 'Section 5 of the proposed bill we believe will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trademark.' Report No. 3147, Dec. 19, 1904, H. of R., 58th Cong., 3d Sess.

"The provision, therefore, that no mark consisting merely in the name of a corporation shall be registered, *is to be construed in harmony with those established principles in respect of the appropriation of corporate names to which we have referred.*" (Italics added)

3. The Court of Appeals below has decided the question here involved in a way probably in conflict with decisions of this Court explanatory of the meaning in the substantive law of trade-marks of the expression "merely a geographical name or term," as set forth in *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, wherein it is stated, p. 463:

"The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade-mark than he would have been to the use of the word 'America', or 'United States', or 'Minnesota', or 'Minneapolis'. These *merely* geographical names cannot be appropriated and made the subject of exclusive property.

They do not in and of themselves, indicate anything in the nature of origin, manufacture, or ownership; and in the present case the word 'Columbia' gives no information on the subject of origin, production or ownership.' (Italics added)

And in *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, wherein it is stated, p. 673:

"And the general rule is thoroughly established that words that do not in and of themselves indicate anything in the nature of origin, manufacture, or ownership, but are merely descriptive of the place where an article is manufactured or produced, cannot be monopolized as a trade-mark." (Italics added).

And wherein it is also stated, p. 677:

"And since, while the secondary signification attributed to its use of the word ('Elgin') might entitle appellant to relief, the fact that, primarily, it simply described the place of manufacture, and that appellees had the right to use it in that sense, though not the right to use it without explanation or qualification, if such use would be an instrument of fraud, we are of opinion that the general rule applied, and that this geographical name could not be employed as a trademark, and its exclusive use rested in appellant, and that it was not properly entitled to be registered as such." (Italics added)

And in *Delaware & Hudson Canal Company v. Clark*, 13 Wall. 311, wherein it is stated, p. 324:

"And it is obvious that the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, and not to the producer...." (Italics added)

And wherein it is also stated, p. 327:

“It must be considered as sound doctrine that no one can apply the name of a district or country to a well known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others *inhabiting* the district or dealing in similar articles *coming from the district* from truthfully using the same designation.” (Italics added)

And in *Brown Chemical Co. v. Meyer*, 139 U. S. 540, wherein it is stated, p. 542:

“The general proposition is well established that words which are *merely descriptive* of the character, qualities or composition of an article, or of the *place where it is manufactured or produced* cannot be monopolized as a trade-mark.” (Italics added)

4. The Court of Appeals below has decided an important question of Federal law upon which there is considerable diversity and un settlement of judicial opinion and which should be definitely settled by this Court in order that this registration Act may hereafter be administered with uniformity and certainty by the Commissioner of Patents and the courts.

(a) The following cases decided by the Commissioner of Patents hold that geographical terms used in an arbitrary and fanciful sense, and obviously not signifying to any ordinary person the place where the goods were produced, are *not* “merely geographical names or terms” within the meaning of the trade-mark registration statute and, therefore, are registrable thereunder:

In re J. A. Folger & Co., 4 T. M. Rep. 41 (S. D.) granting registration to “Shasta” for coffee;

In re Crew Levick Company, 1918 C. D. 51, 255 O. G. 161, granting registration to “Cashmere” for a wool lubricating oil;

In re Fils DeR. Picard & Cie, 9 U. S. Pat. Q. 208, granting registration to “Everest” for watches:

In re Russell-Miller Milling Co., 5 T. M. Rep. 114, 116 MS D. 29, granting registration to "Occident" for bread.

(b) The United States Circuit Court of Appeals for the Eighth Circuit has held that a "mark" which signifies to the public the manufacturer or producer of the goods to which it is affixed is not "merely a geographical name or term" and may be registered under the Act here involved:

Manitou Springs Mineral Water Co. v. Schueler, 239 Fed. 593, 601 (8 C. C. A.)

(c) The instant case and the following recent cases decided by the Commissioner of Patents hold that *all* words which are names of places or localities are, irrespective of any other consideration and without exception, forbidden registration by the terms of the Act here involved:

In re Hettrick M. Mfg. Co., 32 Pat. Q. 164, 475, O. G. 688, where, in refusing registration of "Edgewood," it was held that the language of the statute "leaves no room for exception, but forbids registration of *all* geographical terms, including those with alternative meanings, one of which may be non-geographical."

In re Kraft-Phoenix Cheese Corp., 44 U. S. Pat. Q. 218; 511 O. G. 805; 30 T. M. Rep. 216, where, in refusing registration of "Chantelle", it was said "If a word (geographical name) has no other meaning, it is necessarily 'merely' geographical, regardless of the extent to which it is known." (Affirmed, U. S. Court of Customs and Pat Apps., 28 C. C. P. A. 1153, 120, Fed. 2d 391)

(c) The United States Court of Customs and Patent Appeals, which has appellate jurisdiction in the matter of registration of trade-marks, has interpreted the words "merely a geographical name or term" of Section 5 of the Trade-mark Act of February 20, 1905 differently at different times:

In the case of *In re Plymouth Motor Corporation*, 18 C. C. P. A. 838, 46 Fed. (2d) 211, it is held that if a geographical term has a secondary meaning it is not merely geographical within the meaning of the trade-mark Act of February 20, 1905 and is therefore registerable. In this case the expression "secondary meaning" was not used in its technical trade-mark sense, but simply in the sense of "another meaning."

In the case of *In re Canada Dry Ginger Ale, Inc.*, 24 C. C. P. A. 804, 86 Fed. (2d) 830, the same court has subsequently reached a different conclusion as to the interpretation of the words "merely a geographical name or term" occurring in the Act and has overruled its former holding as to their meaning.

Wherefore your petitioner prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia, commanding said Court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record of all proceedings of the Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; and that the judgment of the Court of Appeals denying that petitioner is entitled to register its trade-mark under the provisions of the trade-mark Act of February 20, 1905 be reversed; and that the petitioner be granted such other and further relief as may seem proper.

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